

### **REMARKS**

Claims 1-26 are pending in this case. Claim 26 is allowed. Claims 27-40 are cancelled herein without prejudice or disclaimer as being drawn to non-elected subject matter. Claims X are cancelled without prejudice or disclaimer. Applicants reserve the right to pursue the subject matter of withdrawn or cancelled claims in one or more continuing or divisional applications. Accordingly, no new matter is added.

#### **Specification**

The disclosure is objected to because some of the drawings have sequences covered by the Sequence Rules (37 § CFR 1.821-1.825), however, these sequences lack the required embedded sequence identifiers (SEQ ID NOs) either in the Drawings or the Brief Description of the drawings in the specification.

The Brief Description of the drawings in the specification is amended herein to insert the required sequence identifiers. Reconsideration and withdrawal of the objection are requested.

#### **Claim Rejections under 35 U.S.C. § 102**

Claims 1-5, 7-19 and 21-25 are rejected under 35 U.S.C. § 102(b) as being anticipated by Pederson et al. (US 5,149,797, newly cited as reference "A").<sup>1</sup> Applicants traverse.

Independent claims 1 and 15 require the steps of contacting or administering, respectively, an *RNA oligonucleotide complex* directed to a non-repaired target RNA, *comprising a first oligonucleotide and a second oligonucleotide*. Claims 1 and 15 further require that the second oligonucleotide comprises an RNA sequence is complementary to at least 6 nucleotides of the first oligonucleotide. Pederson et al. fails to teach or suggest either this minimal length or complementarity requirement for the second oligonucleotide. Moreover, Claims 1 and 15 require that the second oligonucleotide be complementary to the first oligonucleotide at the site in the first oligonucleotide sequence which is not complementary to the target RNA. Pederson et al. also fails to teach or suggest this location requirement for alignment of the second oligonucleotide to the first oligonucleotide. Accordingly, Pederson et al. fails to teach or suggest

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<sup>1</sup> Office Action at page 3.

all elements of claims 1 and 15, and, consequently, those claims subject to the rejection which properly depend therefrom.

For all of the foregoing reasons, the pending claims are novel over Pederson et al. Reconsideration and withdrawal of the rejection are requested.

### **Claim Rejections under 35 U.S.C. § 103**

Claims 1, 6, 15, and 20 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Pederson et al. (US 5,149,797, newly cited as reference “A”) in view of Kole et al. (US 5,627,274, newly cited reference “B”).<sup>2</sup> Applicants traverse.

Pederson et al. fails to teach or suggest all elements of independent claims 1 and 15 for the reasons stated *supra*. Moreover, as conceded by the Examiner, “Pederson et al. does not specifically teach modifying the oligonucleotide with a 2-O-methyl moiety.”<sup>3</sup>

Kole et al. fails to cure the deficiencies of Pederson et al. Kole et al. merely teaches a method of modifying oligonucleotides with a 2-O-methyl moiety. Critically, Kole fails to teach or suggest all other elements of independent claims 1 and 15, from which claims 6 and 20, properly depend.

If the ordinarily skilled artisan were to substitute the 2-O-methyl moieties taught by Kole et al. for the oligonucleotides taught by Pederson et al., he would not reach the instant invention because the combination of Pederson et al. and Kole et al. fail to teach or suggest all elements of the pending claims. Consequently, the ordinarily skilled artisan would have no motivation to combine the teachings of Pederson et al. with Kole et al. with any reasonable expectation of success because this combination cannot reproduce the instant invention.

For all of the foregoing reasons, Applicants submit that a *prima facie* case of obviousness has not been made. The pending claims are nonobvious over the combination of Pederson et al. and Kole et al. Reconsideration and withdrawal of the rejection are requested.

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<sup>2</sup> Office Action at page 6.

<sup>3</sup> *Id.*

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### CONCLUSION

On the basis of the foregoing amendment and remarks, Applicants respectfully submit that the pending claims are in condition for allowance. Should any questions or issues arise concerning this application, the Examiner is encouraged to contact the undersigned at the telephone number provided below.

Respectfully submitted,



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